Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JASPER D. RINE,
VICTOR L. BOYARTCHUK, and
MATTHEW N. ASHBY

Appeal No. 2003-1998
Application No. 09/165,460

ORDER REMANDING TO THE EXAMINER

Before Stoner, Chief Administrative Patent Judge,
HARKCOM, Vice Chief Administrative Patent Judge, and
WILLIAM F. SMITH, Administrative Patent Judge.

WILLIAM F. SMITH, Administrative Patent Judge.

REMAND TO THE EXAMINER

The examiner entered an Examiner's Answer on May 20, 2003 (Paper No. 24). A Reply Brief was received by the U.S. Patent & Trademark Office (USPTO) on August 25, 2003, bearing a "Certificate of Mailing" stating that the correspondence was deposited with the U.S. Postal Service on August 19, 2003. To date, the examiner has

not had an opportunity to review the Reply Brief. Accordingly, we remand the application to the examiner to consider the Reply Brief. In so doing, the examiner should note that the Reply Brief appears to be untimely as it was due within two months from the date of the Examiner's Answer. 37 CFR § 1.193(b)(1). We note appellants state in the last paragraph of the Reply Brief that they petitioned for and authorized charging to their deposit account all necessary extensions of time. However, extensions of time for filing a reply brief are governed by 37 CFR § 1.136(b). See 37 CFR § 1.136(a)(1)(ii).

Apart from the timeliness issue in regard to the filing of the Reply Brief, there is another issue raised in this appeal the examiner should consider upon return of the application. Appellants question in the Appeal Brief the publication date of the references relied upon by the examiner identified as Rose and Lye. In response, the examiner introduced and relied upon new evidence in the Examiner's Answer, i.e., copies of e-mail messages received by USPTO personnel purporting to establish a publication date for the Rose and Lye references. The propriety of the examiner relying upon new evidence in the Examiner's Answer is not apparent. See 37 CFR § 1.193(a)(2) ("[a]n examiner's answer must not include a new ground of rejection . . ..") Applicants state in the Reply Brief that they have had "no opportunity to confront this new evidence." Id., page 1.

An appeal should be decided upon a fixed record, not an ever expanding record. Here, the examiner apparently acquiesced in appellants' argument that the record at the time of the Appeal Brief did not establish that the Rose and Lye publications were publicly available at a time that would qualify them as prior art to the claims on appeal. Rather, the examiner introduced new evidence in an effort to establish that the Rose and Lye references do, in fact, qualify as prior art. However, appellants have not had a full and fair opportunity to respond to the new evidence.

Upon return of the application, the examiner should review the matter and take appropriate action. It appears that the examiner has two options. If the examiner believes the record at the time of the Appeal Brief was sufficient to establish that the Rose and Lye references are available as prior art to the claims under appeal, the examiner could withdraw the original Examiner's Answer and substitute an Examiner's Answer which does not reply upon new evidence, explaining why the facts of record at the time of the Appeal Brief are sufficient. On the other hand, if the examiner agrees with appellants that the facts of record at the time of the Appeal Brief do not establish that the Rose and Lye references are available as prior art and the examiner continues to believe that the new evidence establishes that the Rose and Lye references are available as prior art to the claims on appeal, the examiner should reopen prosecution and allow appellants a full and fair opportunity to respond to the new evidence.

This application, by virtue of its "special" status, requires an immediate action. Manual of Patent Examining Procedure § 708.01 (8th ed., rev. 1, February 2003). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

Bruce H. Stoner, Jr., Chief
Administrative Patent Judge

Gary V. Harkcom, Vice Chief
Administrative Patent Judge

William F. Smith
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

Richard Aron Osman
Science and Technology Law Group
75 Denise Drive
Hillsborough, CA 94010

dem